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EXAMINER

PATTERSON, MARIE D

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3728

17

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 17

Application Number: 09/994,439  
Filing Date: November 26, 2001  
Appellant(s): TSEN ET AL.

**MAILED**  
**MAR 19 2004**  
**GROUP 3700**

Catherine M. McCarty  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 2/19/04.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The amendment after final rejection filed on 2/19/04 has been entered.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-6, 8-27, and 29-32 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

3932950	TABER	1-1976
2481389	CAMPAGNA	9-1949
5572805	GIESE et al.	11-1996

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 8-27, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taber (3932950) in view of Giese (5572805) and Campagna (2481389).

Taber shows a shoe (figure 7) and inherent method of making said shoe comprising a molded rubber outsole (28), a molded midsole (26), an upper (22), a base panel (lower portion of 22) shown above element 26 in figure 7), an insole (24), and foxing (52) substantially as claimed except for the exact sole comprised of an outsole and midsole and the method of bonding the foxing to the upper and sole. Giese teaches forming a sole (figures 78-82) by providing an outsole (5) in a shell shape with a rim and placing the midsole (2 and 3) within the shell shaped outsole and further teaches contouring the midsole. Campagna teaches the use of uncured rubber for a foxing and teaches vulcanizing the foxing (9) to a rubber sole (7) as a method of attaching the foxing to the sole (column 4 lines 20-30). Campagna also teaches placing foxing (9) over a seam formed by the sole (7) and the upper (1), see figure 2. It would have been obvious to provide a sole comprising a contoured midsole and shell shaped outsole as taught by Giese and to form a seam between the outsole and upper and

vulcanize a foxing thereon as taught by Campagna in the shoe and method of Taber to increase comfort, support, stability, durability, etc..

In reference to claim 13, Taber as modified above discloses the claimed invention except for the exact material for the upper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use canvas or PVU (it is noted that Campagna specifically teaches the use of canvas), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In reference to claims 14 and 20, it is extremely well known and conventional to use Stroebel stitching to secure uppers to soles. It would have been obvious to use Stroebel stitching as is well known and conventional to attach the sole to the upper in the shoe of Taber as modified above to make the connection more durable and stronger.

In reference to claims 18 and 31, it is well known and conventional to make insoles removable. It would have been obvious to make the insole of Taber as modified above removable so that it may be cleaned, changed, etc. Also, it is noted that the insole of Taber is considered to be "removable" inasmuch as applicant has defined and claimed such.

In reference to claims 19-26, Taber discloses the method of bonding the midsole and outsole (column 2 lines 7-13) to form a sole, attaching the upper to the sole (column 2 lines 58-68 and shown in figure 7), placing the foxing material around the upper and sole and bonding such substantially as claimed except for the exact sole configuration and the exact method of placing the foxing. Giese teaches making a sole by forming an

outsole as a shell (5, shown in figures 78-82) and placing a contoured midsole (2 and 3) formed by a contoured last therein. Campagna teaches the method of attaching a shell shaped outsole (7) to an upper (1) and placing a foxing (9) over the seam and vulcanizing. It would have been obvious to form the midsole/outsole sole as taught by Giese and to attach the sole to the upper as taught by Campagna in the method of making a shoe of Taber to provide a shoe with increased comfort, stability, durability, etc..

**(11) Response to Argument**

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, all of the references are directed towards shoes and methods of making/forming the shoes which have foxings and molded elements.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement

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on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Taber shows numerous embodiments, this is a fact, but it does not negate the fact that Taber does show a shoe construction having an outsole, midsole, insole, upper, and foxing.

Giese clearly and explicitly teaches and provides the motivation to combine the disclosed shoe soles with any other shoe construction. Giese clearly states that the sole construction comprising an outsole and a contoured midsole "creates a combined flexibility of the shoe bottom" and "a shoe is formed providing cushioning where needed and stability where needed" (see column 2 lines 14-22). This clearly provides motivation to use the disclosed composite outsole/midsole when cushioning, flexibility, and stability are desired. The fact that Giese shows numerous embodiments, merely suggests that it would have been obvious to use any of the disclosed sole structures including the one shown in figures 78-82. One of ordinary skill desiring to increase cushioning, flexibility and stability in a shoe (such as Taber) would clearly look to references such as Giese which clearly teach structures which provide such benefits.

Campagna clearly and explicitly provides the motivation to use the vulcanized foxing in column 2 lines 19-34, i.e. reducing steps in manufacturing, reducing cost, increasing durability, etc.. One of ordinary skill desiring to reduce steps, reduce cost, and to

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increase durability in a sole which has includes a foxing (such as Taber) would clearly

look to references such as Campagna for solutions/structures/methods.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Primary Examiner

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MDP

March 18, 2004

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